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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,395

07/02/2007

Haruhito Sato

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12/04/2007

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

NOTIFICATION DATE

DELIVERY MODE

12/04/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/587,395	<b>Applicant(s)</b> SATO ET AL.	
	<b>Examiner</b> Paul A. Zucker	<b>Art Unit</b> 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/06</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it consists of more than one paragraph. Correction is required. See MPEP § 608.01(b).
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation that "n is 4 to 30 in line 5". There are, however, two instances of the variable n and it is unclear whether they may vary independently or each n has a value identical to that of the other. Claim 1 and its dependents are therefore rendered indefinite.
4. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-4 recites the limitations that "n is 4 to 20", "n is an even number of 4 to 10" and "n is 6", respectively. There are, however, two instances of the variable n and it is unclear which n is referred to or whether the

limitations require both instances to be within the same range or have the same value. Claims 2-4 are therefore rendered indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al (GB 1,239,394 07-1971). Wood discloses (Page 3, Table, last entry) the compound 3-heptylundecanoate ( $n=4 (+2)$ , 5). Wood discloses (Page 2, lines 86-89) the instantly claimed uses of the branched esters as lubricants and plasticizers. Wood therefore anticipates claims 1, 2, 8 and 10.
6. Claims 1-4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ochiai et al (US 5,587,155 12-1996). Wood discloses (Column 2, lines 40-46) a number of compounds of instant formula [1] including, for example, 3-undecyltetradecanoic acid. Ochiai discloses (Abstract) the instantly claimed uses of the branched esters in cosmetic hair compositions. Ochiai therefore anticipates claims 1-4 and 9.
7. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al (US 5,191,072 03-1993). Hasegawa discloses (Column 14, lines 17-32) a number of compounds of instant formula [1] including series of tetradecanoic

and hexadecanoic acids. Hasegawa discloses (Column 5, top, scheme) the formation of an ester with what the Examiner considers a hindered alcohol.

Hasegawa therefore anticipates claims 1-4 and 6.

8. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by O'lenick, Jr. (US 5,191,072 03-1993). O'lenick discloses (Column 2, line 36- column 3, line 14) a number of esters of instant formula [1] including. The Examiner considers these to be esters of hindered isoalkyl alcohols. O'lenick discloses (Column 6, line 11- column 7, line 20) the use of these compounds as lubricants in cosmetic compositions. O'lenick therefore anticipates claims 1-4 and 6.

#### ***Claim Objections***

9. Claims 7 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Allowable Subject Matter***

10. Claims 7 and 11 are drawn to allowable subject matter. The following is a statement of reasons for the indication of allowable subject matter: The esters claimed in claim 7 and the first step of the process set forth in claim 11 are free of art.

#### ***Conclusion***

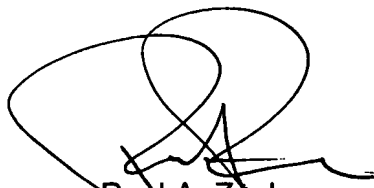
11. Claims 1-11 are pending. Claims 1-11 are rejected. Claims 7 and 11 are objected to.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Evonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul A. Zucker  
Primary Examiner  
Art Unit 1621